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7590

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EXAMINER

JAKETIC, BRYAN J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/401,873

Applicant(s)

SERKIN ET AL.

Examiner

Bryan Jaketic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 & 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 13, 21, and 47. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because in Figure 2A, "interface 21" should presumably be --interface 27-- as listed in the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

On p. 3, line 31, "each a market maker" should be --each market maker--;

On p. 11, line 25, the serial number has been left blank.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites the limitation "the order collector facility" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests applicant change "A collector facility" in line 1 of the claim to --An order collector facility-- to maintain consistency.

7. Claim 3 contains the trademark/trade names SelectNet® and Small Order Execution System®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade names are used to identify/describe order delivery systems and, accordingly, the identification/description is indefinite.

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8. Claim 11 recites the limitation "the auto execution manager" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 14 recites the limitation "the order collector facility" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests applicant change "A collector facility" in line 1 of the claim to --An order collector facility-- to maintain consistency.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1, 2, 4-6, 14-17, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Korhammer et al. Korhammer et al disclose a collector facility (100) for an electronic market comprising an interface (see Fig. 2) for coupling order delivery

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systems (50, 51, 52, 53, and 54) to the order collector facility and a quote manager that manages quotes received at multiple price levels in an aggregate montage or a current quote montage (see Fig. 5). The interface couples the SelectNet negotiation system (604) and execution systems (see col. 5, lines 58-66). It is inherent that when an order is executed, an execution manager executes it at a single point. Korhammer et al do not disclose the use of a "sole point" of execution; however, Applicant's use of the term "single point" in the claims does not preclude the use of additional points of execution for other orders.

12. Claims 1, 6, 7, 14, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith. Smith et al disclose a collector facility for an electronic market comprising an interface for coupling Small Order Delivery Systems to the order collector facility (p. 32-34), a quote manager (p. 33, last paragraph), an order execution manager that executes orders at a single point according to price-time priority (p. 33, middle paragraph).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Korhammer et al. Korhammer et al do not disclose the use of a Small Order Execution

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System. However, the Small Order Execution System is well known in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the Small Order Execution System with the invention of Korhammer et al to allow a user to quickly fill small orders.

15. Claims 8-14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. Smith et al disclose all of the limitations of the claims except for the steps of executing against all displayed sizes of market participants in time priority, and executing any balance against displayed size of non-participants in time priority, or moving to a next price level after a predefined delay if an order is not filled. However, these are common practices in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the practice of executing against all displayed sizes of market participants in time priority, and executing any balance against displayed size of non-participants in time priority to conform to standard practice. Likewise, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the practice of moving to a next price level after a predefined delay if an order is not filled to conform to standard practice.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Garcia discloses a quote manager. Shoham and Clark et al disclose delivery systems. Martyn et al disclose a transaction processing system.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

bj  
June 14, 2002



ROBERT P. OLSZEWSKI  
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